

Dennis R. Sigl

S/N: 10/065,773

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a welding apparatus, and corresponding to claims 1-10.

REMARKS

The Examiner has identified three "inventions" in the pending claims. The Examiner has identified claims 1-10 of Invention I as being drawn to a welding apparatus and classified by the Examiner in class 219, subclass 130.1, claims 11-15 of Invention II as being drawn to a method and classified by the Examiner in class 413, subclass 2, and claims 16-19 of Invention III as being drawn to an article and classified by the Examiner in class 403, subclass Dig. 1.

To support a restriction requirement, the Examiner must set forth the reasons why the inventions claimed are either independent or distinct and the reasons for insisting upon restriction therebetween. In the present application, the Examiner has failed to meet either burden.

The Examiner related Inventions I and II as process and apparatus for its practice under MPEP §806.05(e). MPEP §806.05(e) states, "Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand...." The Examiner stated that "[i]n this case the method can be applied to a snap fit of two tubes."

The Examiner has indicated that the method is applicable to snap-fitting tubes. As such, the Examiner has concluded that the process as claimed can be practiced by another materially different apparatus. However, the subject matter of Invention I is not directed to an apparatus for practicing Invention II. Invention II is directed to a method of assembling a component to the surface of a molded plastic end panel whereas Invention I is directed to a welding apparatus that includes, in part, a molded plastic end panel. Accordingly, Inventions I and II are related as combination and subcombination,

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respectively. As will set forth below, however, there are not reasons for insisting upon restriction on this basis either.

Invention II is directed, in part, to providing a molded plastic panel including a surface having an opening therein and having a polygonal receptacle extending outwardly from the surface formed by a plurality of sides surrounding the opening, the plastic panel also having at least one finger extending outwardly from the surface and having a distal end formed into a barb. Similarly, Invention I, as defined by claim 1, is directed to a welding apparatus having, in part, "a molded end panel having an internal surface facing inwardly toward the enclosed area and an opening formed therein, a receptacle formed on the internal surface surrounding the opening." The receptacle is also defined as having "a plurality of sides extending outwardly from the internal surface forming a polygonal configuration..." Accordingly, both inventions include a polygonal receptacle of a molded plastic panel. As such, Invention II cannot be held to be materially different from Invention I. Moreover, the Examiner lacks reasons for insisting upon restriction as any search of Invention I would necessarily include a search of Invention II.

The Examiner related Inventions II and III as product and process of use under MPEP §806.05(h). The Examiner stated that "[i]n the instant case the end panel can be used as an extension to a cabinet or tube." MPEP §808.02 states that, for a separate classification, "the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation...that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search."

However, Inventions II and III call for elements that require a common field of search. Invention II calls for, in part, providing a molded plastic panel having a surface having an opening therein, and Invention III calls for, in part, a molded plastic body having a surface and an opening formed therein. Invention II calls for, in part, having a polygonal receptacle extending outwardly from the surface formed by a plurality of sides surrounding the opening, and Invention III calls for, in part, a receptacle formed on the surface surrounding the opening, the receptacle comprised of a plurality of sides extending outwardly from the surface forming a polygonal configuration. Invention II calls for, in part, the plastic panel also having at least one finger extending outwardly

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from the surface and having a distal end formed into a barb, and Invention III calls for, in part, at least one flexible finger extending outwardly from the surface and having a distal end formed with a barb. Invention II calls for, in part, providing a component to be affixed to the end panel having a polygonal body and inserting the component into the receptacle, and Invention III calls for, in part, the receptacle adapted to receive a component having a body shaped in the same polygonal configuration of the receptacle. Invention II calls for, in part, causing the barb at the distal end of the at least one finger to hook over the component to retain the component within the receptacle, and Invention III calls for, in part, wherein the at least one flexible finger is adapted to fit over the component to retain the component within the receptacle. Thus, the Examiner has not appropriately explained a separate field of search for Inventions II and III. As such, the Examiner has failed to provide an appropriate explanation for insisting upon restriction and, therefore, Applicant requests that the restriction be withdrawn.

The Examiner related Inventions I and III as subcombinations usable together under MPEP §806.05(d). Applicant respectfully disagrees that Inventions I and III are subcombinations usable together. MPEP §806.05(d) states, "Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other." However, Inventions I and III are not disclosed as subcombinations usable together in a single combination. Instead, Inventions I and III are related as combination-subcombination under MPEP §806.05(c).

Invention I is directed to, in part, a welding apparatus that includes a molded end panel. Claims 1 and 5 of Invention I each define the molded end panel as being incorporated into a respective claimed welding apparatus. Invention III is directed to an end panel, as defined by claim 16. MPEP §806.05(c) states that "inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the sub-combination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations." Where these factors cannot be shown, the inventions are not distinct.

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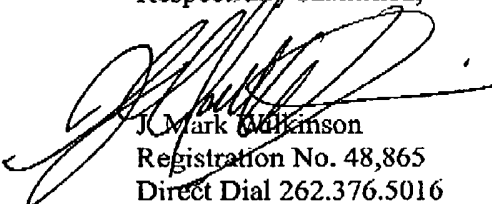
Invention I may be regarded as combination AB_{SP}, and Invention III may be regarded as subcombination B_{SP}. See MPEP §806.05(c)(II). The relationship between these inventions is such that the separately claimed subcombination B_{SP} constitutes a distinguishing feature of the combination AB_{SP} as claimed. In this regard, the combination would not be patentable without the particulars of the subcombination. Therefore, "the inventions are not distinct and a requirement for restriction must not be made, even though the sub-combination has separate utility." MPEP §806.05(c)(II). Because the inventions are not distinct, Applicant requests that the restriction of Inventions I and III be withdrawn.

For all these reasons, Applicant respectfully requests rejoinder of claims 1-19.

Applicant has amended paragraph [0032] of the specification. No new matter has been added.

The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262.376.5016
jmw@zpspatents.com

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P.O. ADDRESS:
Ziolkowski Patent Solutions Group, LLC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170